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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,816	12/01/2003	Thomas L. Clubb	EV31030US	5558
9561	7590	10/28/2008	EXAMINER	
POPOVICH, WILES & O'CONNELL, PA			MACNEILL, ELIZABETH	
650 THIRD AVENUE SOUTH			ART UNIT	PAPER NUMBER
SUITE 600			3767	
MINNEAPOLIS, MN 55402				

MAIL DATE                    DELIVERY MODE  
10/28/2008                    PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/724,816	CLUBB, THOMAS L.
	<b>Examiner</b>	<b>Art Unit</b>
	ELIZABETH R. MACNEILL	3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 October 2008.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,3-36,38-48 and 50-75 is/are pending in the application.
- 4a) Of the above claim(s) 7-11,30-32,34,39-41,44,54-58,66-68,70 and 73-75 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-6,12-29,33,35,37,38,42,43,45-48,50-53,59-65,69,71 and 72 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 7-11, 30-32,34, 39-41,44,54-58,66-68,70 and 73-75 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3 August 2006.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson (US 4,979,951).
2. Simpson teaches a catheter (Fig 3) having:

A first elongate tubular body (108) having a proximal portion (46, Fig 1A), a distal portion (at 101b, just before notch 102), and lumen extending between the proximal and distal end (Fig 4);

A second elongate tubular body (101a) having a proximal end (at 128, just after notch 102) and a distal end (see Fig 3 where guide wire 113 extends from the distal end) and a lumen (guide wire lumen 111);

An elongate member (101, only section with notch 102) joining the first and second tubular bodies;

Further comprising a third elongate member (106) having a proximal portion (cable 116) and a distal portion (cutting edge 157, Fig 7) and a lumen (tube 116 may be hollow, Col 6 line 66, "The cable 116 can be hollow or solid");

At least the proximal portion of the third elongate body being disposed within the lumen of the first body (Fig 2C) and being slid able so that the distal portion of the third body is within the second body (Fig 2D);

Wherein the proximal portion of the third body is maintained within the lumen of the first body by a mechanical stop (161, Fig 7)

As to claim 2, 38, see Fig 3; claims 4,5 Fig 5; claim 6, Fig 3; claim 12, Fig 5; Claim 13,14 Fig 3; claim 15, 16, 17, shaft 107; claim 29, balloon 127; claim 33, Fig 2C; claim 35, plastics are used at Col 2 line 48; claims 45-48, 50-53, 59-65, 69, 71 and 72, see Fig 2A-2E.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 18-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson

Simpson is silent on the specific dimensions of the catheter. Shanley's catheter is sized and shaped to be used in the human vasculature, and therefore must fall within certain anatomical limitations. It would have been well within the skill of one of ordinary skill in the art at the time the invention was made to use the dimensions claimed by the

applicant as a matter of optimization to allow the catheter to be used within the human vasculature.

***Response to Arguments***

Applicant's arguments with respect to claims 1-75 have been considered but are not persuasive. It is unclear why the applicant finds his amendments overcome the rejection when each of the claimed positions of the third elongate member is shown in Simpson Fig 2B-2E. Some explanation or argument of why the applicant believes these features are not shown is required beyond simply asserting that "Simpson does not disclose or teach a catheter having first, second and third elongate tubular bodies having the features required by claim 36" and other claims. The rejection is maintained.

***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH R. MACNEILL whose telephone number is (571)272-9970. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth R MacNeill/  
Examiner, Art Unit 3767  
/Kevin C. Sirmons/  
Supervisory Patent Examiner, Art Unit 3767